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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,646	10/09/2001	Tetsuo Nishikawa	Nanjo C-1	6210
7590 12/23/2003 FLYNN, THIEL, BOUTELL & TANIS, P.C. 2026 Rambling Road Kalamazoo, MI 49008-1699			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/973,646	Applicant(s) NISHIKAWA ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,12 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 12, and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 10/14/03.

The new grounds of rejection as set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-7, 12, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakaki et al. (U.S. 6,364,422).

The rejection is adequately set forth in paragraph 4 of the office action mailed 6/11/03 and is incorporated here by reference.

4. Claims 1-2, 4-7, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gallucci et al. (U.S. 6,300,399).

The rejection is adequately set forth in paragraph 5 of the office action mailed 6/11/03 and is incorporated here by reference.

With respect to newly added claims 16-19, it is noted that col.4, lines 54-57 disclose the use of additional fillers and reinforcements such as metal oxides and metal sulfates such as barium sulfate.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallucci et al. (U.S. 6,300,399) in view of Sakaki et al. (U.S. 6,364,422).

The rejection is adequately set forth in paragraph 10 of the office action mailed 6/11/03 and is incorporated here by reference.

7. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al. (U.S. 6,364,422) in view of Gallucci et al. (U.S. 6,300,399).

The disclosure with respect to Sakaki et al. in paragraph 3 above is incorporated here by reference.

The difference between Sakaki et al. and the present invention is the requirement in the claims of additional ingredient.

Gallucci et al., which is drawn to composition comprising styrene and tungsten as is Sakaki et al., disclose the use of additives such as metal oxides and metal sulfates such as barium sulfate in order to impart good mechanical properties and good processability to the composition (col.4, lines 47-57).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use metal oxide or metal sulfate in the composition of Sakaki et al. in order to produce

composition with good mechanical properties and processability, and thereby arrive at the claimed invention.

Response to Arguments

8. Applicants' arguments regarding Bray et al. (U.S. 6,048,379) and Hayward et al. (U.S. 4,780,981) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

9. Applicants' arguments filed 10/14/03 have been fully considered but, with the exception of arguments relating to Bray et al. (U.S. 6,048,379) and Hayward et al. (U.S. 4,780,981), they are not persuasive.

Specifically, applicants argue that US 6,364,422 to Sakaki et al. is not available as a reference against the present claims given that the thermoplastic resin composition disclosed in US 6,364,422 was disclosed by the present inventors. As evidence to support this position, applicants have submitted a 1.132 declaration.

It is noted that US 6,364,422 names three co-inventors, Sakaki, Kadomaru, and Mizoguchi, two of which, namely, Sakaki and Mizoguchi are inventors of the present application. In the declaration three of the four co-inventors of the present application, namely, Sakaki, Mizoguchi, and Nishikawa, state that they are the true inventors of the thermoplastic resin composition of US 6,364,422.

However, there is no disclosure regarding the fourth co-inventor of the present application, namely, Haruta. Further, in the declaration, applicants state on page 1 that Sakaki, Mizoguchi, and Nishikawa are the "true inventors" of the thermoplastic resin composition

disclosed in US 6,364,422 but on page 2 state that US 6,364,422 was invented independently by its inventors. Further, the disclosure in the declaration that Sakaki, Mizoguchi, and Nishikawa are the “true inventors” of the thermoplastic resin composition of US 6,364,422 is not a satisfactory showing as required under MPEP 716.10 but rather a conclusionary statement without supporting evidence.

The closest related case law to the present situation is *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), however, the present situation appears to be a “reverse” *Katz* situation and thus, the fact pattern is different. That is, in *Katz*, the examiner cited a publication where applicant and two others were named as co-authors and applicant filed a 1.132 declaration to show that applicant was sole inventor of related subject matter disclosed in the publication. In the present application, which names 4 co-inventors, in response to examiner’s use of US 6,364,422 against the present claims which names 2 of the 4 inventors of the present application as co-authors, applicants must show that the third and fourth co-inventors of the present application are also co-inventors of US 6,364,422.

Although the fact pattern in *Katz* is different than in the present situation, it is noted that in *Katz*, applicant overcame rejections by stating in 1.132 declaration that he was the sole inventor of the subject matter described in the publication. However, in the 1.132 declaration filed 10/14/03 in the present application, there is no such statement that all the inventors of the present application are the sole inventors of the subject matter in US 6,364,422. Of relevance to the present situation is *Ex parte Magner, Long, Ellis, and Grinstead*, 33 USPQ 404 wherein a publication, by three of the four inventors of instant application, was removed as a reference by such three inventors’ affidavit wherein not only did the inventors state they were authors of the

publication and that they were three of four co-inventors of invention claimed in application, but also that fourth co-inventor and themselves mutually participated in conception, research, and reduction to practice of claimed invention of the publication, and that publication was prepared from research records of themselves and fourth co-inventor. In the present declaration, there is no disclosure in the declaration regarding the fourth co-inventor of the present application, Haruta.

For the reasons set forth above, it is the examiner's position that applicants' 1.132 declaration does not provide a satisfactory showing to establish that the inventors of the present application are the sole inventors of the subject matter in US 6,364,422 and thus, the declaration is not successful in removing this patent as a reference against the present claims.

(b) Applicants also argue that Gallucci et al. is not available as a reference against the present claims in light of Japanese patent application 11-95712 which establishes that the present inventors had invented the claimed subject matter of the present invention prior to the effective filing date of Gallucci et al.

However, as noted by applicants, the present application does not claim priority to JP 11-95712. Thus, applicants cannot rely on the filing date of this reference to overcome Gallucci et al.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

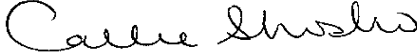
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS
12/11/03


Callie E. Shosho
Primary Examiner
Art Unit 1714